



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,431	04/06/2001	Imaddin Othman Albazz	CA920000034US1	6091
36736	7590	08/30/2004	EXAMINER	
DUKE W. YEE YEE & ASSOCIATES, P.C. P.O. BOX 802333 DALLAS, TX 75380			ELISCA, PIERRE E	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,431

Applicant(s)

ALBAZZ ET AL.

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3621

DETAILED ACTION

1. This Office action is in response to Applicant's response, filed on 06/02/2004.
2. Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 are pending.
3. The rejection to claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 under 35 U.S.C. 103 (a) as being unpatentable over Shkedy in view of Hoyt as set forth in the Office action mailed on 06/02/2004 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14, 16, 17, 19-27, 29-36, 38-46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (U.S. Pat. No. 6,260,024) in view of Hoyt et al. (U.S. pat. No. 6,067,531).

As per claims 1, 2, 3, 5, 20-22, 24, 26, 27, 29-32, 34, 36, 38-41, 43, and 45, 46 and 48 Shkedy substantially discloses a global bilateral buyer-driven system for creating binding contracts by incorporating various methods of communication, commerce and security for the buyers and the sellers, comprising:

Art Unit: 3621

a computer for storing at least one contract (see., abstract, col 3, lines 39-57, specifically wherein it is stated that buyers and sellers purchase requirements or plurality of rules);

storing set containing parameters (see., abstract, figs 2 and 3, col 2, lines 1-9, col 5, lines 32-67);

generating links between the contract (see., col 5, lines 7-60, fig 5);

interlocking the links to lock the contract (see., col 7, lines 26-42).

Shkedy fails to explicitly disclose wherein said compilation of business rules and storing terms and conditions. However, Hoyt discloses an automated contract negotiator/generation system/method in which multiple users, coupled by a computer network, access a contract database containing multiple contracts with multiple contract components therein. A client applet facilitates user input at the client system and assists in a standardization of legal phrasing and contract negotiation. The client applet enforces business rules to qualify a contract for expedited approval (see., abstract, col 1, lines 5-47, col 2, lines 12-56. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the commercial network system of Shkedy by including the limitation detailed above as taught by Hoyt because this would support approval policies by applying business rules to control specific contract terms.

Art Unit: 3621

As per claims 4, 23, 33, and 42 Shkedy discloses the claimed limitations wherein the contract comprises dynamic elements which can be unilaterally altered by either the seller or the buyer (see., abstract, col 7, lines 26-42).

As per claims 6, 25, 35, and 44 Shkedy discloses the claimed limitation wherein the contract is locked by the implementation of digital signature (see., figs 2, 12, and 14, specifically signature keys, col 47-67).

As per claims 7-9, 11, and 13, 14, 16, 17 and 19 Shkedy discloses the claimed method of a global bilateral buyer-driven system for creating binding contracts by incorporating various methods of communication, commerce and security for the buyers and the sellers, comprising:

storing at least one contract (see., abstract, col 3, lines 39-57, specifically wherein it is stated that buyers and sellers purchase requirements or plurality of rules);

storing set containing parameters (see., abstract, figs 2 and 3, col 2, lines 1-9, col 5, lines 32-67, please note that parameters are readable as specify prices at which he will purchase);

generating links between the contract (see., col 5, lines 7-60, fig 5);

interlocking the contract (see., col 7, lines 26-42, specifically pre-negotiate a supply contract with a major supplier). Shkedy fails to explicitly disclose wherein said compilation of business rules and storing terms and conditions. However, Hoyt discloses an automated contract negotiator/generation system/method in which multiple

Art Unit: 3621

users, coupled by a computer network, access a contract database containing multiple contracts with multiple contract components therein. A client applet facilitates user input at the client system and assists in a standardization of legal phrasing and contract negotiation. The client applet enforces business rules to qualify a contract for expedited approval (see., abstract, col 1, lines 5-47, col 2, lines 12-56. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the commercial network system of Shkedy by including the limitation detailed above as taught by Hoyt because this would support approval policies by applying business rules to control specific contract terms.

As per claim 10, Shkedy discloses the claimed method wherein the contract comprises dynamic elements which can be unilaterally altered by either the seller or the buyer (see., abstract, col 7, lines 26-42).

As per claim 12, Shkedy discloses the claimed method wherein the contract is locked by the implementation of digital signature (see., figs 2, 12, and 14, specifically signature keys, col 47-67).

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 06/02/2004 have been fully considered but they are not persuasive.

Art Unit: 3621

REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record taken alone or in combination fail to anticipate or render obvious the recited feature:

a. "storing at least one terms and conditions of business rules". As indicated above, Shkedy fails to explicitly disclose wherein said compilation of business rules and storing terms and conditions. However, Hoyt discloses an automated contract negotiator/generation system/method in which multiple users, coupled by a computer network, access a contract database containing multiple contracts with multiple contract components therein. A client applet facilitates user input at the client system and assists in a standardization of legal phrasing and contract negotiation. The client applet enforces business rules to qualify a contract for expedited approval (see., abstract, col 1, lines 5-47, col 2, lines 12-56. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the commercial network system of Shkedy by including the limitation detailed above as taught by Hoyt because this would support approval policies by applying business rules to control specific contract terms.

b. "any type of correspondence between these parameters". However, the Examiner respectfully disagrees since Shkedy discloses this limitation in col 5, lines 7-60, fig 5, col 7, lines 26-42, contract negotiation between seller and buyer).

c. "Applicant also maintains that Shkedy and Hoyt cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the

Art Unit: 3621

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In *re Fine*, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Eli Lilli & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App & Inter); and *Es parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to *Ex parte Levengood*, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, *In re Keller*, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound

Art Unit: 3621

scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

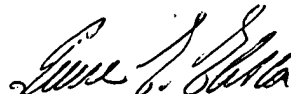
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

August 25, 2004